

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sho Kuwamoto, et al.	Art Unit : 2176
Patent No. : 7,526,720	Examiner : Laurie Anne Ries
Issue Date : April 28, 2009	Conf. No. : 5315
Serial No. : 09/991,766	
Filed : November 23, 2001	
Title : SYSTEM AND METHOD FOR STORING DATA ASSOCIATED WITH A FILE	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 479 to 1004 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before January 23, 2003 (the date that is fourteen months after November 23, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on October 4, 2004, thereby according a PTO Delay of 620 days. Patentee does not dispute the PTO's calculation for this “A Delay” from January 24, 2003 (the day after the date that is fourteen months after the date on which the application was filed), to October 4, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 620 days.

“B Delay”

The period beginning on November 24, 2004 (the day after the date that is three years after November 23, 2001, the date on which the application was filed), and ending April 28, 2009 (the date the patent was issued), is 1617 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on May 2, 2006, and the patent issued on April 28, 2009, resulting in a period of 1092 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 525 days (i.e., 1617 days minus 1092 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 525 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

January 24, 2003, to October 4, 2004.

As detailed above, "B Delay" accumulated during the following period:

November 24, 2004, to May 2, 2006.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before January 4, 2005 (the date that is three months after October 4, 2004, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on February 10, 2005, thereby according an Applicant Delay of 37 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 5, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to February 10, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before August 13, 2005 (the date that is three months after May 13, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on August 17, 2005, thereby according an Applicant Delay of 4 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from August 14, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to August 17, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before February 2, 2006 (the date that is three months after November 2, 2005, the date on which the Office Action was mailed). Patentee filed

Applicant : Sho Kuwamoto, et al.
Patent No. : 7,526,720
Issued : April 28, 2009
Serial No. : 09/991,766
Filed : November 23, 2001
Page : 4 of 5

Attorney's Docket No.: 07844-0729001 / M144

a response to the Office Action on May 2, 2006, thereby according an Applicant Delay of 89 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from February 3, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to May 2, 2006. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on April 18, 2007, subsequent to a reply filed on April 11, 2007. Patentee was accorded a delay of 7 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from April 12, 2007, to April 18, 2007. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before September 22, 2007 (the date that is three months after June 22, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 24, 2007, thereby according an Applicant Delay of 2 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from September 23, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to September 24, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before June 21, 2008 (the date that is three months after March 21, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 23, 2008, thereby according an Applicant Delay of 2 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 22, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to June 23, 2008. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 141 days (i.e., the sum of 37 days, 4 days, 89 days, 7 days, 2 days, and 2 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Applicant : Sho Kuwamoto, et al.
Patent No. : 7,526,720
Issued : April 28, 2009
Serial No. : 09/991,766
Filed : November 23, 2001
Page : 5 of 5

Attorney's Docket No.: 07844-0729001 / M144

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 479 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1145 days (i.e., the sum of 620 days of "A Delay" and 525 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 141 days (i.e., the sum of 37 days, 4 days, 89 days, 7 days, 2 days, and 2 days); and
- 3) Total PTA should be calculated as 1004 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0729001.

Respectfully submitted,

Date: June 29, 2009

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